

Remarks

Claims 1-40 were pending in the subject application. By this Amendment, claims 1, 2, 15, 16, 19-21 and 29-40 have been cancelled without prejudice or disclaimer to pursue the cancelled subject matter in a continuation or divisional application. Applicants have amended claims 3-6, 10-13, 17, 18, 23 and 26-28.

Claim 3 has been amended into an independent claim by incorporating the definitions of the variables from previous claim 1 and by deleting the definitions of particular variables without prejudice or disclaimer to pursue the deleted subject matter in a continuation or divisional application. Support for new claim 3 can be found in the specification, as originally filed, on page 13, line 4 through page 14, line 11 and page 14, line 16 through page 15, line 7. Multiple dependent claims 4-6 and 10-13 have been amended to be dependent on a single claim. Claims 17 and 18 have been amended by deleting certain definitions of particular variables without prejudice or disclaimer to pursue the deleted subject matter in a continuation or divisional application. Support for new claims 17 and 18 can be found in the specification, as originally filed, on page 13, line 4 through page 14, line 11 and page 19, line 11 through page 20, line 13. Additionally, claims 23 and 26-28 have been amended to correct punctuation errors and change claim dependencies.

Applicants respectively submit that the amendments to the claims are fully supported by the description and that no new matter has been added. Accordingly, upon entry of this Amendment, claims 3-14, 17, 18 and 22-28 will be pending and under examination.

I. Objection to Claims

On page 3 of the Office Communication, the Examiner objected to claim 1 for using non-standard abbreviations for variables, when no variable actually exists (due to the restriction requirement). Specifically, the Examiner stated that the letter B has an accepted meaning in that it is the symbol for the element boron.

In response, Applicants have cancelled claim 1 thereby rendering this ground of rejection moot. Accordingly, Applicants respectively request that the Examiner withdraw this ground of objection.

II. Claim Rejections – 35 USC 102(a)

The Examiner rejected claims 1-3 and 26-28 under 35 USC 102(a) as being anticipated by Salon, et al. WO 2002002744 and asserted that Salon et al. teaches a compound (Chemical Abstracts RN 387827-32-9) of the instant case with the same utility and compositions thereof.

In response, Applicants have cancelled claims 1 and 2 thereby rendering this ground of rejection to claims 1 and 2 moot. Applicants have amended claim 3 to only allow R₄ to be – COR₃ or a phenyl, optionally substituted. Amended claims 26-28, which now depend on claim 3, do not cover the compound of Chemical Abstracts RN 387827-32-9. Accordingly, Applicants maintain that the amended claims 3 and 26-28 are not anticipated by Salon, et al. and respectively request that the Examiner reconsider and withdraw this ground of rejection.

III. Claim Rejections – 35 USC 102(e)

On page 4 of the Office Communication, the Examiner rejected claims 1-3 and 26-28 under 35 USC 102(e) as being anticipated by Salon, et al. WO 2002002744 and asserted that Salon et al. teaches a compound (Chemical Abstracts RN 387827-32-9) of the instant case with the same utility and compositions thereof.

In response, Applicants have cancelled claims 1 and 2 thereby rendering this ground of rejection to claims 1 and 2 moot. Applicants have amended claim 3 to only allow R₄ to be – COR₃ or a phenyl, optionally substituted. Amended claims 26-28, which now depend on claim 3, do not cover the compound of Chemical Abstracts RN 387827-32-9. Accordingly, Applicants maintain that the amended claims 3 and 26-28 are not anticipated by Salon, et al. and respectively request that the Examiner reconsider and withdraw this ground of rejection.

III. Claim Rejections – 35 USC 112, first paragraph

The Examiner further rejected claims 1-14, 17, 18, and 26-28 under 35 USC 112, first paragraph, and asserted that while being enabling for compounds wherein R is H, R₄ is phenyl or C(=O) and R₂ is alkyl or phenyl, the specification does not reasonably provide enablement for the full scope of compounds bearing the extensive list of substituents.

In response and in an attempt to advance the prosecution of the subject application but without conceding to the correctness of the Examiner's position, Applicants have cancelled claims 1 and 2 thereby rendering this rejection to claims 1 and 2 moot. Applicants have amended claims 3, 17 and 18 to limit the definitions of the following variables: R is H; R₄ is C(=O)R₃ or phenyl, optionally substituted; and R₂ is alkyl or phenyl, optionally substituted. Applicants note that claims 4-14, 17, 18 and 26-28 ultimately depend on amended claim 3 and incorporate the limitations placed on definitions of the variables of amended claim 3.

Accordingly, Applicants maintain that amended claim 3 and its dependent claims 4-14, 17, 18 and 26-28 are fully enabled by the specification and respectively request that the Examiner reconsider and withdraw this ground of rejection.

III. Double Patenting

On page 8 of the Office Action, the Examiner provisionally rejected claims 1-14, 17, 18 and 22-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of co-pending U.S. Application No. 11/034,611. The Examiner asserted that although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same compounds.

In response, upon the indication of allowable subject matter, Applicants will consider filing a terminal disclaimer to overcome the obviousness-type double patenting rejection.

Conclusion

In view of the above remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue. If a telephone interview would be of assistance in advancing prosecution of the above-identified application, the undersigned invites the Examiner to telephone the number provided below. No fee, besides the fee for a one-month extension of time, is deemed necessary with the filing of this Amendment. However, if any additional fee(s) is required, authorization is hereby given to charge such fee(s) to Deposit Account No. 503201.

Respectfully submitted,

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